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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,771	11/04/2003	Marlene C. Schwarz	12013/53907	5897

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EXAMINER

LAMB, BRENDA A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

8

Office Action Summary	Application No. 10/699,771	Applicant(s) SCHWARZ ET AL.	
	Examiner Brenda A. Lamb	Art Unit 1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8,26,32-35,40 and 42-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,4,5,42 and 44-45 is/are allowed.
- 6) ☒ Claim(s) 3,6-8,26,32-35,40 and 43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3,7,8,26,32-35,40 and 43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The originally filed specification fails to teach or suggest that the cage is a stent or the cage is a vena-cava filter. The subject matter of "the cage is a stent" or "the cage is a vena-cava filter" is not reasonably conveyed by the original disclosure. The description of "the cage is a stent" or "the cage is a vena-cava filter" is redefining the invention in a manner not contemplated by applicant in the original disclosure, which teaches that the medical device 410, but not the cage 420, may be the stent or vena-cava filter. In the original disclosure, "cage" and "stent" or "vena-cava filter" are different concepts. In particular, the original disclosure describes the cage as functioning as a support for a medical device such as a stent or vena-cava filter whereas the original disclosure describes the stent or vena-cava filter as being a medical device instead of an apparatus which functions as a support for another medical device.

The originally filed specification fails to teach or suggest that the vibration structure, positioned in the coating chamber, having one or more exposed sides, wherein at least one exposed side has a space between it and the coating chamber.

Note the recitation that the vibrating structure has one or more exposed sides broadly reads on the vibrating structure having an infinite number of sides while the Figures 6-9 show the vibrating structure having a finite number of sides such as Figure 8 which shows the vibrating structure is a vibrating container 840 having a flat bottom and two sets of opposing sides.

If applicant disagrees then he needs to point out support in the specification and/or drawings for a vibration structure having an infinite number of sides.

The originally filed specification fails to teach or suggest the vibration source may move independently from the coating chamber. Note the last office action had a typographical error in that it should have included claim 8 as being rejected under 35 USC 112, first paragraph since claim 8 includes the limitation that the vibration source may move independently from the coating chamber. Applicant's argument that the coating chambers depicted and described with respect to Figures 6-8 show the chambers as a generally stationary vessel is found to be non-persuasive since the originally filed specification fails to describe the coating chambers depicted in Figures 7-9 as being a generally stationary vessel. Further, one skilled in the art would have expected the support for the vibrating structure, which contacts the vibrating structure, would result in the vibration of the coating chamber along with the vibrating structure since no means for insulating the support for the vibrating structure, which is supported by and in contact with the bottom wall or extends through and as shown in applicant's drawings is in contact the bottom wall of the coating chamber, from vibration is disclosed.

The originally filed specification fails to teach or suggest the vibration source may move independently from the screen. One skilled in the art would have expected the support for the vibrating structure, which contacts the vibrating structure, would result in the vibration of the coating chamber along with the vibrating structure and screen supported therein since no means for insulating the support for the vibrating structure, which is supported by and in contact with the bottom wall or extends through and as shown in applicant's drawings is in contact the bottom wall of the coating chamber, from vibration is disclosed.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Alkan et al.

Alkan et al teaches the design of an apparatus for coating a medical implant as shown in Figure 1. Alkan et al apparatus is comprised of the following elements: a coating chamber or cavity which is defined by funnel 1; a vibration source, the vibration source adapted to suspend a medical device in the coating chamber; and a coating source, the coating source positioned to introduce coating into the coating chamber wherein the coating source includes a nozzle 13 coupled to a supply of coating and wherein the vibration source is positioned below and not directly coupled to a screen 3 which is arranged in the lower portion of the coating chamber defined by funnel 1, and wherein the vibration source is adapted to generate pressure waves of compressible fluid containing enough energy to lift a medical device positioned in the coating chamber away from the screen 3. Thus element of the claimed apparatus as set forth in claim 6 is taught by Alkan et al.

Applicant's arguments filed 6/22/2006 have been fully considered but they are not persuasive.

Applicant's argument that Alkan et al does not teach the negative limitation that vibration source is not directly coupled to a screen since amplifier 8 is directly coupled to screen 3 is not understood. Alkan et al discloses the screen 3 is glued or directly coupled to funnel 1 or coating chamber and the funnel 1 is supported by supporting tube 4 and supporting tube 4 is supported on the metal lid 7 which is glued to amplifier 8 and

therefore the examiner maintains that Alkan et al teaches the negative limitation that vibration source is not directly coupled to a screen.

Claims 2,4,5,42 and 44-45 are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

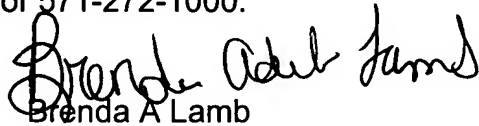
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda A. Lamb whose telephone number is (571) 272-1231. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday with alternate Wednesdays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1734

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Brenda A. Lamb".

Brenda A Lamb
Examiner
Art Unit 1734